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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/747,937
Filing Date: December 27, 2000
Appellant(s): CURTIN, STEVEN D.

Steven J. Hanke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/09/2010 appealing from the Office action mailed 01/08/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-22.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5936786	Go	08-1999
5877906	Nagasawa	03-1999
6442108	Kurihara	08-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 5, and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Go (US Pat. No. 5, 936, 786) in view of Nagasawa (US Pat. No. 5,877,906).

Regarding claim 1, Go discloses an electronic write protect apparatus for storage media (see figure 3) comprising:

at least one record element for writing information to a given magnetic storage media (see claim 1 where it teaches a recording means for writing information on recording medium, tape);

a pre-existing electronic information signal detection element to read a pre-existing electronic information signal stored on said given magnetic storage media (see claims 1 and 2 where Go recites signal detecting means for detecting the presence or absence of a control pulse from a recording medium),

a record deactivation circuit to prevent recording on said given magnetic storage media when said pre-existing electronic information signal detection element detects said pre-existing electronic information signal stored on said given magnetic storage media (see abstract, col. 1 line 53-67, col. 2 line16-col. 3 line 39, claims 1-6, recording is only performed when the control pulse is not detected by the signal detecting means, and if control

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pulse is detected recording is deactivated to prevent unintentional erasure of the information recorded on the recording medium).

claim 1 differs from Go in that the claim further requires the said deactivation occurring at or about a time of occurrence of said detection of said pre-existing signal.

In the same field of endeavor Nagasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13 lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508. Therefore in light of the teaching in Nagasawa it would have been obvious to one of ordinary skill at the time the invention was made to modify Go by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data.

Regarding claim 3, Go discloses at least one record element is attached to a spinning element (see figures 1 and 3, video tape is attached to a spinning element).

Regarding claim 5, Go discloses pre-existing electronic signal detection element is attached to said spinning element (see claims 1 and 2 where Go

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recites signal detecting means for detecting the presence or absence of a control pulse from a recording medium wherein the recording medium is attached to a spinning element).

Regarding claim 6, Go discloses the said given magnetic storage media is a video tape (figure 1, col. 1 lines 16-30, and col. 2 lines 18-23).

Regarding claim 7, Nagasawa discloses magnetic tape storing digital information (see col. 3 lines 53-65, col. 18 lines 23-31 and lines 38-46).

3. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurihara et al. (US Pat. No. 6,442,108) in view of Go (US Pat. No. 5, 936, 786) and further in view of Nagasawa (US Pat. No. 5, 877, 906).

Regarding claim 1, Kurihara discloses an electronic write protect apparatus for storage media (see figure 2) comprising:

at least one record element for writing information to a given magnetic storage media (see figure 2, recording and tape 15);

a pre-existing electronic information signal detection element (the CPU performs the process shown in figure 6 which includes S1-6) to read a pre-existing electronic information signal (the pre-existing electronic signal is previously recorded data, audio, song title, or count) stored on said given magnetic storage media (see figure 6, CPU determine if the tape is blank or

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not, i.e. CPU determines whether or not previously recorded audio data (pre existing signal) can be found in the tape),

Claim 1 differs from Kurihara in that the claim further requires a record deactivation circuit to prevent recording on said given magnetic storage media when said pre-existing electronic information signal detection element detects said pre-existing electronic information signal stored on said given magnetic storage media.

In the same field of endeavor Go discloses a record deactivation circuit to prevent recording on said given magnetic storage media when said pre-existing electronic information signal detection element detects said pre-existing electronic information signal stored on said given magnetic storage media (see abstract, col. 1 line 53-67, col. 2 line16-col. 3 line 39, claims 1-6, recording is only performed when the control pulse is not detected by the signal detecting means, and if control pulse is detected recording is deactivated to prevent unintentional erasure of the information recorded on the recording medium by confirming that the portion on which the information is recorded is a blank portion and recording new information on the blank portion). Therefore in light of the teaching in Go it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kurihara by including an activation and deactivation circuit in order to prevent essential recorded information from being erased.

Claim 1 further differs from the above combination in that the claim further requires the said deactivation occurring at or about a time of occurrence of said detection of said pre-existing signal.

In the same field of endeavor Negasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13 lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508. Therefore in light of the teaching in Nagasawa it would have been obvious to one of ordinary skill at the time the invention was made to modify the above proposed combination by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data.

Regarding claim 3, Kurihara discloses at least one record element is attached to a spinning element (see figure 2, components 15, 27, 29 and 30).

Regarding claim 5, Kurihara discloses pre-existing electronic information signal detection element is attached to said spinning element (see figure 2, components 15, 26, and 27).

Regarding claim 6, Kurihara discloses the said given magnetic storage media is a video tape (see figure 2 and col. 3 lines 34-39, and see also Go et al. figure 1 and col. 1 lines 16-30).

Regarding claim 7, Kurihara discloses storage media stores digital information (see col. 4 lines 37-40). See also Nagasawa's col. 3 lines 53-65, col. 18 lines 23-31 and lines 38-46.

4. Claims 9, 11, 14, 16, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurihara et al. (US Pat. No. 6,442,108) in view of Official Notice and further in view of Nagasawa (US Pat. No. 5, 877, 906).

Regarding claim 9, Kurihara discloses an electronic write protect method for storage media comprising: attempting to record information on a given tape placed in a cassette player (see figure 6); detecting a pre-existing signal from the said given tape (the CPU performs the process shown in figure 6 which includes S1-6 where Kurihara discloses detecting a signal recorded on the tape to determine if the tape is blank or not); and deactivating a record circuit in the said cassette player (see figure 2, figure 6, S1-06 and S1-13, when the tape is not blank, the data is not recorded at the selected position, Note also that S1-6 and then S1-7 to S1-12 is not processed (not activated) if the tape is not a blank tape, i.e. S17-S1-12 is deactivated).

Claim 9 differs from Kurihara in that the claim further requires the pre-existing signal is a video signal. Although Kurihara does not specifically disclose the tape records/recorded video data, Kurihara discloses an audio data recorded on the tape. Official Notice is taken that it is well known in the art at the time the invention was made to record video signal in tape. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kurihara by adding a video signal in the tape in order to record moving image data.

Claim 9 further differs from the above combination in that the claim further requires the said deactivating performs at or about a time of occurrence of said detection of said pre-existing signal.

In the same field of endeavor Nagasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13 lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508. Therefore in light of the teaching in Nagasawa it would have been obvious to one of ordinary skill at the time the invention was made to modify the above

proposed combination by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data.

Regarding claims 11 and 18, Kurihara discloses attempting to record information is performed by a spinning element (see figure 2, components 15, 27, 29 and 30).

Regarding claims 14 and 21, Kurihara discloses the said video tape stores digital information in magnetic form (see col. 4 lines 37-40).

Regarding claim 16, the limitation of claim 16 can be found in claim 9 above. Therefore claim 16 is analyzed and rejected for the same reasons as discussed in claim 9.

(10) Response to Argument

Appellant states, "Go is explicit that the blank portion of the recording medium to be used to for recording new infoamtion is 'selected from among the detected portions' there is no teaching that Go selects the first (or last for that matter) blank portion of the recorded medium to record the new information."

In response the Examiner respectfully disagrees. As admitted clearly by the Appellant and discussed in the applied prior art selection of portions is performed. As the word 'selection' indicates, the portions that are selected can be first or last. The prior art does not explicitly teach unselecting the first nor the last to that matter.

Appellant further states, "on the contrary, Go, at lines 49-50 of column 2, teaches 'the head is positioned at the starting point of the selected blank region' (emphasis added). Go does not teach that the head is position to the starting point of any region."

In response the Examiner respectfully disagrees. Appellant states Go does not teach any blank but selected blank region. Any blank region in the information medium encompasses selected region in the information medium. The selected blank region can be the first region, regions in the middle, or last region, and these regions are basically any regions in the recording medium.

After the above two statements Appellant then concludes, "the principle of operation of Go is to scan an entire recording medium, detect control pulses that mark used portions of the recording medium, select a portion of the recording medium where no control pulses were detected, and position a recording head at the selected portion of recording medium to record new information."

The Examiner agrees that the prior art of Go teaches scanning of the entire medium. In addition to that the prior art also teaches setting up an information recording mode which includes 1) recording is to be performed from the present position of a tape loaded in a deck, 2) the recording is to be performed on a selected blank position. When the mode blank position is

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selected, scanning is performed on the entire medium in order to select a blank position, And deactivation is performed on the portion where control pulse is existed. Similarly if the first mode is selected to perform recording on the present position, signal detecting means detects the presence or absence of a control pulse (see claim 2 of the prior art for example where the art recites selecting an information mode and performing detection, deactivation and/or recording performed). The mode includes modes 1 and 2 as disclosed in the prior art col. 2 lines 18-23. Therefore the prior art teaches deactivating recording on the present position or scan the entire recording medium portions first then record.

Appellant states, "modifying Go to deactivate recording at or about the time of occurrence of a control pulse, thereby NOT scanning the entire medium first, would clearly change the principal of operation of Go."

In response the Examiner respectfully disagrees. First, Appellant has not explained, nor is apparent, how and why the prior art of Go's principal of operation would change if modifies. Appellant have not provided any analysis in support of this position. This position is based on assumption. Instead of scanning the entire portion, one skill in the art can modify the prior art just by scanning one portion, leading one skill in the art to subtract a feature from among a plurality of features.

Second, Negasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13 lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508.

Third, and most important, Go teaches selecting a recording mode that recording to be performed at the **present** position of the tape. Deactivating recording at the present position will not change the operation of GO. But Go already teaches deactivating at the present position.

Appellant concluded that because Go scans the entire portions first, deactivation of recording does not occur at or about a time of occurrence of the said detection of the said pre-existing signal.

This is simply not true. In the second mode of Go where scanning of the entire tape is performed, go deactivates recording if pre-existing signals detected. The limitation 'at a time of occurrence' in the claim can be broadly interpreted and Go does not teach scanning of the entire tape performed this week and recording is performed next year to that matter. Go clearly teaches detecting, deactivation or activation and recording all performed one after the other, i.e. at the time of occurrence.

Furthermore Appellant states support of the limitation of "deactivation occurring at or about a time of occurrence of said detection of said pre-existing signal" can be found in page 5 line 22-page 6 line 29 and figure 1 of the original specification.

The examiner reviewed the sections above further and unable to locate such limitation. Line 11-14 of page 6 states spinning the head clockwise and the pre-existing signal detection element sweep past moving video tape to **detect or record** information thereon. Hence the Application does not explicitly discloses detecting only a portion of the tape , or sweeping pre-existing signal element past the video tape on only a portion of the tape, the spinning performed on the entire tape. The Application also does not disclose stop spinning when detecting pre-existing signal. The spinning occurs and detection or recoding is performed after spinning or scanning the tape. From this portion of the disclosure and figure 1, one can conclude that detection of pre-existing signal is performed by spinning the entire tape clockwise.

In addition if the prior art of Go includes a control pulse in all portions of the recording medium, recording of new information disabled. Hence disclosure of page 6 lines 24-29 of the present Application meet.

In addition the term "deactivation occurring at or about a time of occurrence of said detection of said pre-existing signal" is not defined nor located in the specification and thus must be given its broadest reasonable

interpretation consistent with Appellants' disclosure. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Appellant states, "Kurihara does NOT teach the limitation of deactivating a record circuit as detection of a pre-Existing occurs as recited in pending independent claim 9."

First, the CPU of Kurihara performs the process shown in figure 6 which includes S1-6 where Kurihara discloses detecting a signal recorded on the tape to determine if the tape is blank or not); and at S1-06 and S1-13, when the tape is not blank, the data is not recorded at the selected position, Note also that S1-6 and then S1-7 to S1-12 is not processed (not activated) if the tape is not a blank tape, i.e. S17-S1-12 is deactivated.

Second, Appellant's arguments against the Kurihara references individually, cannot show nonobviousness where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, the secondary reference of Negasawa teaches deactivating recording operation at or about a time of detecting pre-existing information signal (see figure 11 steps 306, 310 and 311 where the prior art teaches deactivating a recording operation when the remaining amount of the video tape of the video tape cassette is the set value X or greater, see also col. 13

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lines 20-26 and col. 14 lines 1-13). See also figure 13 steps 362-363, figure 14 steps 405, 407 and 410, figure 15 steps 505, 507 and 508.

Fourth, the phrase "deactivating a record circuit in said video cassette **at or about a time of occurrence of said detection of said-pre-existing signal**" is not defined nor located in the specification and thus must be given its broadest reasonable interpretation consistent with Appellants' disclosure. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Appellant stated the prior arts in combination with **Official Notice** not provide a prima facie case of obviousness for pending independent claim 9.

In response the Examiner respectfully disagrees. In addition to the reasons stated above, the prior art of Go (for Official Notice), cure the said deficiencies as stated above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/HELEN SHIBRU/

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Examiner, Art Unit 2621

Helen Shibru

Conferees:

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